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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,583	05/11/2005	Takahide Kishimoto	235670	7802

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EXAMINER

MEAH, MOHAMMAD Y

ART UNIT PAPER NUMBER

1652

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/534,583	Applicant(s) KISHIMOTO ET AL.	
	Examiner Mohammad Meah	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-18,20,25,27,28,35 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,3,5-18,20,25,27,28,35 and 41 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

1. The claims 1, 3, 5-18, 20, 25, 27-28, 31, 35 and 41 are pending in the instant office action.

### ***Restriction***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1, 3, 5, 6,8, 10, drawn to modified sarcosine oxidase wherein amino acid residue 155 of SEQ ID NO: 1 is modified.

Group II. Claims 1, 3, 5, 6,8, 11, drawn to modified sarcosine oxidase wherein amino acid residue 166 of SEQ ID NO: 1 is modified.

Group III. Claims 1, 3, 5, 6,8, 12, drawn to modified sarcosine oxidase wherein amino acid residue 204 of SEQ ID NO: 1 is modified.

Group IV. Claims 1, 3, 5, 6,8, 14, drawn to modified sarcosine oxidase wherein amino acid residue 233 of SEQ ID NO: 1 is modified.

Group V. Claims 1, 3, 5, 6,8, 15, drawn to modified sarcosine oxidase wherein amino acid residue 240 of SEQ ID NO: 1 is modified.

Group VI. Claims 1, 3, 5, 6,8, 16, drawn to modified sarcosine oxidase wherein amino acid residue 250 of SEQ ID NO: 1 is modified.

Group VII. Claims 1, 3, 5, 7-9, 18, 20, 25, 31, drawn to modified sarcosine oxidase wherein amino acid residue 89 of SEQ ID NO: 1 is modified.

Group VIII. Claims 1, 3, 5, 6-8,13, drawn to modified sarcosine oxidase wherein amino acid residue 213 of SEQ ID NO: 1 is modified.

Group IX. Claims 1, 3, 5, 7-8,17, drawn to modified sarcosine oxidase wherein amino acid residue 364 of SEQ ID NO: 1 is modified.

Group X. Claims 18, 20, 25, 27,31, drawn to modified sarcosine oxidase having a lowered action on L-proline compared with one before modification, wherein amino acid residue 94 of SEQ ID NO: 1 is modified.

Group XI. Claims 18, 20, 25, 28,31, drawn to modified sarcosine oxidase having a lowered action on L-proline compared with one before modification, wherein amino acid residue 322 of SEQ ID NO: 1 is modified.

Group XII. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 155 is modified and have sarcosine oxidase activity.

Group XII. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 166 is modified and have sarcosine oxidase activity.

Group XIII. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 204 is modified and have sarcosine oxidase activity.

Group XIV. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 233 is modified and have sarcosine oxidase activity.

Group XV. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 240 is modified and have sarcosine oxidase activity.

Group XVI. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 250 is modified and have sarcosine oxidase activity.

Group XVII. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 213 is modified and have sarcosine oxidase activity.

Group XVIII. Claim 35, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 364 is modified and have sarcosine oxidase activity.

Group XIX. Claim 42, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 89 is modified and have sarcosine oxidase activity and have a lowered action on L-proline compared with one before modification.

Group XX. Claim 42, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 94 is modified and have sarcosine oxidase activity and have a lowered action on L-proline compared with one before modification.

Group XXI. Claim 42, drawn to a gene encoding a protein comprising modified SEQ ID NO: 1 wherein amino acid residue 322 is modified and have sarcosine oxidase activity and have a lowered action on L-proline compared with one before modification.

The inventions listed as Groups I-XIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I, II, -, -, X and group XI proteins do not share a corresponding special technical feature as each of these proteins has different structure and function.

Groups I-XI proteins and groups XII-XXI DNAs do not share a corresponding special technical feature as each of these products has different structure and function and utilities.

Furthermore', the technical feature linking group I-XXI appears to be that they all relate to modified sarcosine oxidase. Modified sarcosine oxidase does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature, which defines a contribution over the prior art, as modified sarcosine oxidase is known thorough US PAT 6958231.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Art Unit: 1652

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/534,583

Page 7

Art Unit: 1652

A handwritten signature in black ink, appearing to read 'M Meah'. The signature is fluid and cursive, with the first letter 'M' being large and stylized.

Mohammad Younus Meah, PhD  
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